UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/540,469	03/31/2000	Gregory J. Clary	5808-2	2484

826 7590 11/16/2005

ALSTON & BIRD LLP
BANK OF AMERICA PLAZA
101 SOUTH TRYON STREET, SUITE 4000
CHARLOTTE, NC 28280-4000

EXAMINER	
NGUYEN, CHANH DUY	
ART UNIT	**PAPER NUMBER**
2675	

DATE MAILED: 11/16/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	09/540,469	CLARY, GREGORY J.	
	Examiner	Art Unit	
	Chanh Nguyen	2675	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *25 May 2005*.

2a)☒ This action is **FINAL**. 2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-71* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-71* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ .
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

DETAILED ACTION

Response to Remarks

1. The remarks filed on May 25, 2005 has been entered and considered by examiner.

Claim Rejections - 35 USC § 103

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

3. Claims 1-71 are rejected under 35 U.S.C. 103(a) as being unpatentable over Leichner et al (U.S. Patent No. 6,050,490) in view of Gusack (U.S. Patent No. 5,921,582).

As to claim 43, Leichner discloses a pen (15) enabled computing device(11) adapted for use with a preprinted form (form 14) comprising a page (14) having a writing surface (e.g., surface of page 14), a visual form identifier (bar code 27) disposed on the writing surface (i.e. surface of page 14) and adapted to identify the nature of the page to a user (see column 4, lines 3-19). Leichner teaches a bar code (27) defined by the writing surface and arranged to correspond to the nature of the page, the nature of the page comprises a function and a specific identity (see column 4, line3-19). Leichner teaches a pen (15) enabled computing device (11) including: a writing stylus (15). Leichner teaches a sensing device (digitizer section 13) adapted to engage the

preprinted form (14) and cooperating with the writing stylus (15) such that the pen enabled computing device is actuated when the writing stylus is disposed adjacent to the writing surface in interactable relation with the bar code(27) and is thereby enabled to determine the nature of the page as data is input into the bar codes (27) with the writing stylus (15) according to the user-identified nature of the page (see column 4, lines 3-39)..

The only different from the claim and the reference of Leichner is that Leichner uses the barcodes to identify the nature of the page while the claim requires a plurality of fields corresponding to the nature of the page. In same field of endeavor (preprinted form; see column 14, lines 22-27)), Gusack teaches a plurality of fields (column 629) corresponding to the nature of the page (e.g., page section 3, page 19, corresponding page "Cabinetry Project for Office") (see Figure 6). Therefore, it would have been obvious to one of ordinary skill in the art at the invention was made to have used a plurality of fields to identify the nature of page as taught by Gusack to the preprinted form device of Leichener because Gusack's indexing system provides a highly organized record structure that allows for any degree of integration of paper-based systems with electronic-based informational assemblies (see column 3, lines 1-18 of Gusack.

As to claim 50, this claim differs from claim 43 only in that claim 50 is method whereas claim 43 is apparatus. Thus, method claim 50 is analyzed as previously discussed with respect to apparatus claim 43.

As to claims 1 and 22, these claim differ from claim 43 in that the limitation "a computer program product" is additional recited. Gusack clearly a computer product executing within the pen enabled computing and cooperating therewith (see column 10, lines 45-61, column 13,lines 60-67, column 14,lines 23-40.

As to claims 2, 23, 44 and 51, Leichener an electronic handwriting tablet capable of interacting with the pen enabled computing device and the preprinted form so as to sense the position and movement of the writing stylus with respect to a page engaged with the handwriting tablet (se column 6,line 65-68, column 8,lines 24-25).

As to claims 3, 24, 45 and 52, Leichener teaches the preprinted form comprises a plurality of pages (e.g., 14 and 20) having a predetermined order (14 is top or first page and 20 is the last page)and the system is further capable of determining a function and a specific identity for each page corresponding to the order (i.e. each page has a bar code 27 identifier) as broad claimed language.

As to claims 4, 2, 46 and 53, combine the writing surface(surface of page 14) according nature of the page (14) and the pen (15) enable computing device (11) as taught Leichener with captured data input in a plurality of fields (i.e. field S, P, R 629) to determine the nature of the page of Gusack would meet the claimed limitation.

As to claims 5, 26, 47 and 54, combine plurality of fields (i.e. field S, P, R 629) to determine the nature of the page of Gusack and the pen (15) enable computing device (11) as taught Leichener a would meet the claimed limitation "the data-containing fields to define a corresponding base n number that uniquely identifies the nature of the page to the pen enabled computing device as recited in the claimed

As to claims 6, 27, 48 and 55, it would have been obvious that Gusack teaches computer program product cooperate to define a base n number that corresponds to a transposable matrix having n rows and m+1 columns forming (n)* (m+1) matrix elements, each matrix element having a value corresponding to $j*n^i$ and being represented by the coordinates (j, i), with i varying from 0 to m and j varying from 0 to n-1 since Gusack teaches identifying the nature of the page by using a plurality of field as shown in Figure 6 which is the same way as the Figure 3 of the invention

As to claims 7, 28, 49 and 57, Leichener computer program product further cooperates with the pen (15) enabled computing device (11) to access data stored within the pen enabled computing device. Gusack teaceshthe data accessed by said computer program product is selected from the group consisting of data that is associated with the specific identity of the page and data that is independent of the specific identity of the page (see figure 6). Thus, combining Leichener and Gusack would meet the claimed limitation.

As to claims 8, 29 and 58, Leichener clearly teaches a user interface (25) wherein the computer program product is further adapted to cooperate with the user interface (25) to provide data to the user; see column 4,lines 62-64.

As to claims 9, 30 and 59, Leichener teaches the computer program product has determined the nature of the page (e.g., barcode 27), the pen enabled computing device and the computer program product cooperate to further determine whether data input into the barcode continues to correspond to the determined nature of the page and to indicate an error if the input data fails to correspond (see column 9, lines 22-26).

Thus, combining data input into the fields of Gusack to the pen enabled computing device would meet the claimed limitation.

As to claims 10, 31 and 60, combing Leichner teaches the user interface is further capable of indicating the error to the user and prompting the user to correct the error through the pen enabled computing device (see column 5,lines 11-23).

As to claims 11, 32 and 62, Gusack clearly teaches at least one of the fields containing data, the data contained within the data-containing fields, and the number of fields containing data (se figure 6, figure 19).

As to claims 12, 33 and 62, Leichner teaches computer program product cooperates with the pen (15) enabled computing device (11) to detect, capture, and store handwritten data input into a field (i.e. application form) with the writing stylus by spatially segmenting the handwritten data and correlating the spatial segments with the nature of the page as broad claimed language.

As to claims 13, 34 and 63, Gusack teaches the computer program product being further capable of assigning a stamp to data input into a field, the stamp corresponding to the nature of the page and comprising at least one of a time, a date, and a unique identifier (see Figures 19-20).

As to claims 14, 35 an 64, Gusack teaches an editing actuator and the computer program product being further capable of cooperating with the input device enabled computing device to edit data upon actuation of the editing actuator (i.e. adding another record); see column 23, lines 35-38.

As to claims 15, 36 and 65, Gusack teaches the device to allow at least one of addition of data to data contained within a field, insertion of data between data elements contained within a field (i.e. adding another record); see column 23, lines 35-38.

As to claim 16, 37 and 66, Gusack teaches the computer program product is further capable of determining whether data is being input into a data-containing field having a preassigned stamp and prompting the user through the user interface to verify that the user intends to edit the data within the field if data is being input into a data-containing field having a preassigned stamp (see column 23, liens 35-38).

As to claims 17, 38, 67, Leichner teaches the computer program product being further capable of cooperating with the pen enabled computing device to at least one of export data and import data in relation to at least one of an external computing device (i.e. a remote computer) and the pen enabled computing device (see column 4,lines 40-49).

As to claims 18, 39 and 68, Leichner teaches the computer program product being further capable of reconciling transmission of data corresponding to the nature of a page at least one of between the pen enabled computing device and the external computing device (i.e. remote computer), within the pen enabled computing device, and within the external computing device (i.e. remote computer); see column 4, lines 40-49.

As to claims 19, 40 and 69, Leichner teaches the computer program product being capable of allowing at least one of the pen enabled computing device and the external computing device to access data corresponding to the nature of a page

and to examine and manipulate data contained within the fields thereof; see column 4, lines 40-49.

As to claims 20-21, 41-42 and 70-71, Gusack clearly teaches conversion actuator capable of selectively directing data contained within a field to be converted into text (i.e. convert field P, R, S into text or document).

Response to Arguments

4. Applicant's arguments filed May 25, 2005 have been fully considered but they are not persuasive.

On page 17, last paragraph, applicant argues that "neither the Leichner patent nor the Gusack patent, taken individually or in combination, teach or suggest identifying the nature of a paged upon a data input into a plurality of fields defined by a writing surface of the page". Examiner totally disagrees with applicant this point of view because Gusack clearly teaches the limitation above. For example, the nature of page (e.g., page 18 of section 3) is identified based on a data input into a plurality of fields (i.e. S, P, R) defined by a writing surface of the page (i.e. entering one or more fields of S, P, R on a preprinted form so that the information that page 18 can be viewed) (see column 18, lines 24-48.

On page 18, second paragraph, applicant argues that "even in such an instance, the combination of the Leichner and Gusack patents only teach a system whereby the pages upon which a stylus of the pen-enable computing device writes comprise form pages indexed in accordance with the Gusack system. The pen-enabled computing device of the combined system still identify the nature of the pages based upon bar

codes printed thereon, instead of based upon data input into the fields of the page, as in the claimed invention". However, it is not clear how applicant comes up the combination two references above with the results of "combined system still identify the nature of the pages based upon bar codes printed thereon". The combining to references of Leichner and Gusack does not necessary to eliminate the field as taught by Gusack as applicant's analogy. Another way that , why does applicant not analyze that combining both references of Leichner and Gusack would eliminate the bar codes of Lechner and use the field of Gusack or possibility that combining both references would result of keeping both bar codes of Leichner and the fields of Gusack.

On page 19, first paragraph, applicant argues that "modifying the system with teaching necessary resulting in eliminating the need of bar code scanner to scan a form isentifire, then would eliminate the primary purpose of the Leichner system to provide a dual purpose stylus". However, examiner would like to present his point of view as follows: First, applicant's analogy contradicts his/herself because on page 18, second paragraph of the Remarks, applicant states that "the pen-enabled computing device of the combined system still identify the nature of the pages based upon bar codes printed thereon, instead of based upon data input into the fields of the page, as in the claimed invention". Then page 19, second paragraph of the Remarks, applicant states that "combining the device would eliminate the need of bar code. Secondly, applicant does not take into consideration that combining both references would result of keeping both bar codes of Leichner and the fields of Gusack.

Conclusion

5. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Chanh Nguyen whose telephone number is (571) 272-7772. The examiner can normally be reached on Monday- Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Sumati Lefkowitz can be reached on (571) 272-3638. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Chanh Nguyen
Primary Examiner
Art Unit 2675

CN

C. Nguyen
October 31, 2005